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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,976	05/14/2001	Scott LeKuch	YOR920000704US3	9088

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EXAMINER

SHENG, TOM V

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,976

Applicant(s)

LEKUCH ET AL.

Examiner

Tom V Sheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 7, 9-15, 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruedisueli et al. (US Patent 5838819).

As to claim 1, Ruedisueli teaches a digitizer input system (figures 1-4; electronic notepad 10) for inputting written information from a user, said input device system comprising:

at least one sheet of a writing medium (sheet of paper 30) having a unique identifier located thereon (identifier 36 at the upper right corner; column 3, lines 40-46; column 4, lines 39-56);

an electronic pen for writing on said writing medium and emitting one or more signals for generating pen stroke information (figure 9; Ruedisueli teaches that pen device 114 can be electronically connected to notepad 10 by a signal-carrying cable for providing data signals to processor 12 through writing on the notepad surface 26; column 8, lines 50-64);

a detector (figure 1; handwriting capturing device 24 having operative surface 26) for detecting said unique identifier and said pen stroke information from said emitted

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signal (column 3, lines 23-28; column 4, lines 5-17; column 8, line 65, - column 9, line 2); and

local storage (memory 16) for storing said detected pen stroke information, in association with the unique identifier of said writing medium (figures 4 and 5; column 4, lines 31-38; column 5, lines 16-32; column 6, lines 12-23).

As to claim 2, Ruedisueli teaches wherein said input system is coupled to a computing device (figure 1; processor 12; column 3, lines 1-4).

As to claim 3, Ruedisueli teaches wherein said unique identifier is at least one of an image or an alphanumeric string (column 4, lines 46-67).

As to claims 4 and 5, Ruedisueli teaches tracing over said unique identifier with a number, letter, or other characters (column 4, lines 39-56). Further, the identification is automatic such that the notepad 10 can even generate successive number or letter, based on the first written identifier in the upper right corner.

As to claims 7 and 9, Ruedisueli teaches a display for displaying said unique identifier (output device 20 of notepad 10 can be a display; figure 1; column 3, lines 29-33).

As to claim 10, Ruedisueli teaches access of stored stroke information associated with a unique identifier by repeating the identifier first (column 6, lines 4-11).

As to claim 11, Ruedisueli teaches a method of using an input device system, said method comprising the steps of:

indicating a unique identifier located on a writing medium (figure 2; writing a number or letter at the upper right corner of a paper) to said input system (electronic

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notepad 10) using an electronic pen (figure 9; signal-carrying pen 114) for writing on said writing medium, the pen emits one or more signals (inherent) for generating pen stroke information therefrom;

detecting said unique identifier information (figure 1; handwriting capturing device 24 having operative surface 26);

detecting said pen stroke information that is derived from said emitted signal (figure 4; element 40); and

storing said detected pen stroke information in association with said detected unique identifier (figures 3 and 4; element 46; column 4, lines 15-17). See also analysis of claim 1.

Claims 12 and 13 are rejected per analyses of claims 7, 9 and 11.

Claim 14 is rejected per analyses of claims 4 and 11.

Claim 15 is rejected per analyses of claims 5 and 11.

As to claim 18, Ruedisueli teaches a storage medium having computer readable program instructions (figure 1; stored programs 18) embodied therein for inputting information from a user to an input system, said storage medium comprising:

program instructions that are responsive to an indication of a unique identifier (a number or letter written) located on a writing medium (upper right corner) provided to said input system by emissions from an electronic pen (pen 114), said program instructions further being responsive to a detection of said unique identifier information derived from said pen emissions and to detected pen stroke information derived from said pen emissions (element 40); and

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program instructions for storing said stroke information in association with said detected unique identifier (figure 4, element 46; column 3, lines 35-47; figure 5; column 5, lines 13-32). See also analysis of claim 1.

Claims 19 and 20 are rejected per analyses of claims 7, 9 and 18.

Claim 21 is rejected per analyses of claims 5 and 18.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 8, 16-17, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruedisueli.

As to claim 6, Ruedisueli teaches using upper right corner as the region for unique identifier. Ruedisueli is silent, however, on that region being user specifiable. On the other hand, this is merely an option to provide more preferences, which does not make a patentively distinct feature. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to enhance the identifier region to be selectable, in order to accommodate personal preference.

As to claim 8, Ruedisueli does not teach associating a time stamp with detected pen stroke information. On the other hand, Ruedisueli teaches that the identifier can also be generated by a timestamp using a timer (column 4, lines 65-67). The generation of a timestamp type of unique identifier and the association of a timestamp

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to pen strokes (in probably a page or session) are just different ways of applying a time signature to a piece of information.

Claim 16 is rejected per analyses of claims 6 and 11.

Claim 17 is rejected per analyses of claims 8 and 11.

Claim 22 is rejected per analyses of claims 6 and 18.

Claim 23 is rejected per analyses of claims 8 and 18.

Response to Arguments

5. Applicants' arguments filed 6/30/2003 have been fully considered but they are not persuasive.

Applicants argue that the instant application uses a pre-existing identifier.

Applicants also argue that the system would automatically know which page is being written on, without the user needing to identify the page.

The examiner disagrees because the limitation "having a unique identifier located thereon" does not necessarily mean having a pre-existing or pre-printed unique identifier. Thus, Ruedisueli's invention still reads on above limitation. Moreover, applicants' unique identifier is not **automatically** detected as argued but actually requires an entry of a unique identifier at a predetermined or user-determined unique identifier location region first. See figure 3 and paragraphs 38. Further, in the case of pre-existing unique identifier, the instant application still requires a tracing or scanning operation before the unique identifier is recognized. See paragraph 33.

Conclusion

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6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom V Sheng whose telephone number is (703) 305-6708. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Amare Mengistu
Primary Examiner

TS
August 26, 2003